

### **REMARKS/ARGUMENTS**

The Office Action of 6/26/06 has been carefully reviewed and these remarks are responsive thereto. Claim 1 has been amended to incorporate limitations from claims 5 and 6 and claims 5 and 6 canceled without prejudice or disclaimer. Reconsideration and allowance of the instant application are respectfully requested.

#### ***Rejections Under 35 U.S.C. § 103***

Claims 1-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,961,416, hereinafter “Summers,” in view of U.S. Pat. No. 6,584,076, hereinafter “Aravamudan.” The Examiner has substituted Summers for a reference to Kung et al, which, belonging to AT&T Corp., has been dropped as a primary reference against the claims in this second non-final Office Action. The Examiner continues to apply Aravamudan.

In order to establish a *prima facie* case of obviousness under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. *See* MPEP § 706.02 (j); *In re Vaack*, 947 F.2d 488 (Fed. Cir. 1991). Neither Summers nor Aravamudan teach or suggest the claim limitations or provide any motivation to combine them as will be further discuss below – also, a reasonable expectation of success of the combination is placed in doubt.

In the first instance, the Examiner has misread Summers as follows per 2. of the Office Action: “in a private network” and the like. Applicants have conducted a search using the USPTO web site access to a searchable text version of Summers and have assured themselves that the only appearance of the word “private” appears at column 3, line 41 in the context of Figure 1 in which a PSTN 12 (Public Switched Telephone Network) “is meant to include any suitable network or networks, public or private.” This is no teaching of a private network as claimed; moreover, how can the well known PSTN be made private? As can be seen in Figure 1 of Summers, there exists a PSTN 12 and a separate IP network 14. There is no comment or suggestion in Summers about IP network 14 being private. The Examiner points to an IP caller

16b and an associated terminal shown in Figure 1 and in Figure 2 in greater detail but 16b is in IP network 14 which is not disclosed as being a private network. Consequently, Summers fails as a teaching of the claims of the present application because the claims of amended independent claim 1 and independent claim 16 are directed to VoIP stations in a private network.

The Examiner admits at page 4 that “Summers does not disclose the claimed establishing an RTP voice path with the first VoIP station for joining a VoIP call between the plurality of communication stations” and looks to Aravamudan for the deficiencies. Firstly, Aravamudan, per Figure 4 discloses #5ESS central offices which comprise well known public switched telephone central office types connecting subscribers to a conference bridge. Aravamudan fails to use the word “private” and so teaches away from a private network. Applicants have no reason to doubt that Aravamudan relates to a public network.

The Federal Circuit has repeatedly stated that the limitations of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and that the Patent Office should *rigorously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. *Id.* (emphasis added). Thus, Applicants respectfully submit that that there is no motivation or suggestion to combine Summers, which discloses an internet-enabled conferencing system and method accommodating PSTN and IP traffic where no VoIP station is in a private network, with Aravamudan, which discloses a public network. Even assuming that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, as is often argued by the Office, the Office Action provides no evidence that the combination takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, nor does the Office Action provide any evidence that the combination does not include knowledge gleaned only from Applicant’s disclosure. Thus, the combination is an improper combination based on hindsight.

Moreover, independent claim 1 as amended now contains limitations, for example, defining a “receiving . . .” step that cannot be found in either reference as neither reference discloses the step as amended, namely, “receiving an indication comprising a code number identifying a connection in the private network” wherein “at least one of the plurality of the

communication stations is a second VoIP station in a private network and said first VoIP station is in the private network.” The Examiner has failed to locate in Summers (or Aravamudan) any VoIP stations in a private network where the only allegedly private network is the PSTN 12 of Figure 1 of Summers. Applicants therefore respectfully submit the rejection is improper, and request that it be withdrawn. There is no suggestion or motivation to combine the teachings of the cited references as suggested by the Examiner, there exist missing claimed elements not shown by either reference and no reasonable expectation of success of the combination.

Claim 16 includes similar limitations to claim 1 and adds the RTP mixer which the Examiner admits is not in Summers where a conference call involves first and second VoIP stations in a private network (not shown by either reference).

Claims 1-4 and 7-31 are allowable for all the reasons given above concerning their respective base claims 1 as amended and claim 16, and further in view of their specific recitations that have not been shown to be in (or obvious from) the prior art. In the event the rejections are maintained, the examiner is requested to cite supporting evidence, as required by MPEP § 2144.03.

**CONCLUSION**

All rejections having been addressed, applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the Examiner is requested to contact the undersigned at (202) 824-3000.

Respectfully submitted,  
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Dated this 26th day of September, 2006

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